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GROUP 1600

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Hiles, et al.  
Serial No. : 09/325,095  
Filed : June 3, 1999  
For : Method For Determining Expression of a P13 Kinase Gene  
Group Art Unit : 1645  
Examiner : J. Hines

OFFICIAL

September 21, 2001

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Attn: SPE - Lynette Smith

Hon. Commissioner of Patents  
and Trademarks  
Washington, D.C. 20231

REQUEST TO HAVE FINALITY OF OFFICE ACTION VACATED

A final rejection issued in the above-referenced application on September 13. Applicants hereby request that the finality of the action be vacated.

Applicants request this because the examiner has presented rejections for the first time which were not necessitated by applicants' amendment, and could have been made previously.\*

At page 4 of the action, at point 9, the examiner rejects claims 39-50 under 35 USC § 112, first paragraph. According to the examiner:

"The claims set forth the nucleic acid molecules recited in SEQ ID NO: 12, 14-18, 21-22, 24-25, 27-29. However, neither the specification nor the

\* Applicants will not comment on the substance of the rejection herein.

claims teach how to define the variables G, H, Y or W as recited within the sequences."

An extended rejection based upon what the Interim written Description Guidelines allegedly state then follows.

If one reviews the application history, it will be seen that the subject application was filed concurrently with a preliminary amendment which set forth, inter alia, claims 32 and 33.

These read as follows:

32. The method of claim 27, wherein said nucleic acid molecule comprises a nucleotide sequence set forth in SEQ ID NO.: 12, 14, 15, 16, 17, 18, 21, 22, 24, 25, 27 or 29.

33. The method of claim 31, comprising contacting said sample with a pair of oligonucleotide primers, said pair selected from the group consisting of (i) SEQ ID NOS: 12 and 14, (ii) SEQ ID NOS: 15 and 16, (iii) SEQ ID NOS: 17 and 18, (iv) SEQ ID NOS: 21 and 22, (v) SEQ ID NOS: 24 and 25, and (vi) SEQ ID NOS: 27 and 29.

These claims were acted on in an office action, dated November 20, 2000 (paper number 7). Claims 31 and 32 were rejected on prior art grounds only.

In a subsequent office action, dated February 27 2001 (paper number 9), the examiner specifically held that SEQ ID NOS: 12, 14-18, 21, 22, 24, 25, 27 and 29 satisfied the written description requirement. See point 4 of that action, at page 3. Also note the last paragraph of page 4:

"Therefore only an isolated nucleic acid molecule comprising a nucleic acid sequence consisting of SEQ ID NO: 12, 14-18, 21-22, 24, 25, 27 or 29 but not the full breadth of the claims meet the written description portion of 35 USC 112, first paragraph."

No issues were raised with respect to the use of G, H, Y and W,\*\* although there has been ample opportunity for these issues to be raised. To raise them for the first time, and to render an office action which raises the issue "final," is inappropriate and improper. As such the finality should be withdrawn.

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\*\* The examiner's is invited to review MPEP 2422, table 1, for approved abbreviations for nucleotides.

Prompt and favorable action on this request is solicited, so as to avoid the necessity of a formal petition.

Respectfully submitted,

FULBRIGHT & JAWORSKI, L.L.P.



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